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EXAMINER

ENGLAND, DAVID E

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 01/30/2004

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/943,894

Applicant(s)

ANDERSON, ERIC D.

Examiner

David E. England

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11 - 29, 37 - 44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11 - 29, 37 - 44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 15.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 11 – 29, 37 – 44 are presented for examination.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 11 – 13, 16 – 24, 27 – 29, 37 – 39, 41 – 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon U.S. Patent No. 6067561 in view of Arnold (6275848).
3. As per claim 11, Dillon teaches a computer-implemented method for sending an Email communication to recipients, the method comprising:
 4. receiving an indication of an Email communication and of at least one recipient to receive the Email communication, (e.g. col. 1, line 25 – col. 2, line 38);
 5. if it is determined that multiple recipients have been indicated,
 - a. storing the Email communication, (e.g. col. 3, lines 12 – 65);
 - b. notifying each of the multiple recipients of the Email to communication without sending the Email communication to the recipients, (e.g. col. 1, line 25 – col. 2, line 38 & col. 3, lines 12 – 65);
 6. in response to a request for the Email communication from a recipient, sending the Email communication to the recipient, (e.g. col. 1, line 25 – col. 2, line 38 & col. 3, lines 12 – 65).

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Dillon does not specifically teach determining whether multiple recipients of the Email communication have been indicated in the received indication. Arnold teaches determining whether multiple recipients of the Email communication have been indicated in the received indication, (e.g. col. 4, line 25 – col. 5, line 25). It would have been obvious to one skilled in the art at the time the invention was made to combine Arnold with Dillon because it would be more efficient for a system to acknowledge when multiple recipients have been indicated so if the sender needed to know which recipient did not receive an Email the sender could resend the Email to the recipients that are missing the Email or have misplaced it.

7. As per claim 12, as interpreted by the Examiner, Dillon teaches if it is determined that multiple recipients have not been indicated, sending the Email communication to the recipient without waiting for a request for the Email communication, (e.g. col. 1, line 25 – col. 2, line 6).

8. As per claim 13, Dillon teaches the use of storing and sending Email communication but does not specifically teach tracking the sending of the Email communication to the recipients; and

9. when the Email communication has been sent to all of the recipients, deleting the stored Email communication. Arnold teaches tracking the sending of a communication to the recipients, (e.g. col. 4, line 25 – col. 5, line 25); and

10. when a communication has been sent to all of the recipients, deleting the stored Email communication, (e.g. col. 4, line 25 – col. 5, line 25). It would have been obvious to one skilled in the art at the time the invention was made to combine Arnold's limitation of deleting an

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attachment after all recipients have viewed it with Dillon's limitation of storing Email because it is common for systems to utilize a Email server to store Email for recipients and if a group of recipients have all viewed the Email and no longer desire the use of the stored Email on the Email server then it would be advantageous for the Email to be deleted so the Email server can have more space for other Emails that are to be sent.

11. As per claim 16, Dillon does not specifically teach determining a period of time for which the Email communication will be stored; and

12. when the determined period of time has expired, deleting the stored Email communication. Arnold teaches determining a period of time for which the Email communication will be stored, (e.g. col. 4, line 25 – col. 5, line 25); and

13. when the determined period of time has expired, deleting the stored Email communication, (e.g. col. 4, line 25 – col. 5, line 25). It would have been obvious to one skilled in the art at the time the invention was made to combine Arnold with Dillon because of reasons disclosed above, furthermore, if a user has information that is forgotten for a period of time, the system could delete this information, therefore freeing up space in memory.

14. As per claim 17, as interpreted by the Examiner, Dillon teaches wherein the notifying of a recipient of the Email communication involves sending a distinct indicator Email communication to the recipient, (e.g. col. 9, line 60 – col. 10, line 40).

15. As per claim 18, Dillon teaches including retrieving notifying instructions for a recipient, and wherein the notifying of the recipient is performed according to the notifying instructions, (e.g. col. 3, line 36 – col. 4, line 41).

16. As per claim 19, Dillon does not specifically teach wherein the notifying instructions are supplied by a sender of the Email communication. Arnold teaches wherein the notifying instructions are supplied by a sender of the Email communication, (e.g. col. 4, line 25 – col. 5, line 25). It would have been obvious to one skilled in the art at the time the invention was made to combine Arnold with Dillon because if the sender needed specific functions to be carried out with the Email communication it would be more efficient for a system to have the sender send instructions to a Email server to only allow specific recipients in a group to access the Email communication, delete the Email at a specific time, automatically send the Email to recipients at a specified time, etc.

17. As per claim 20, Dillon teaches wherein the notifying instructions are supplied by the recipient, (e.g. col. 3, line 36 – col. 4, line 41).

18. As per claim 21, Dillon does not specifically teach wherein the notifying instructions are determined automatically based on past interactions with the recipient. Arnold teaches wherein the notifying instructions are determined automatically based on past interactions with the recipient, (e.g. col. 5, line 25 – col. 6, line 49). It would have been obvious to one skilled in the

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art at the time the invention was made to combine Arnold with Dillon because it is a more efficient way to have a Email communication dealt with, therefore saving time on the users side.

19. As per claim 22, Dillon teaches wherein the notifying instructions indicate that the notifying is to be performed in an encrypted manner, (e.g. col. 9, line 60 – col. 10, line 14).

20. Claims 23, 24, 27 – 29, 37 – 39 and 41 - 43 are rejected for similar reasons as stated above.

21. Claims 14, 15, 25, 40, 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (6067561) in view of Arnold (6275848) in further view of Foladare et al. (6311210) (hereinafter Foladare).

22. As per claim 14, Dillon and Arnold do not specifically teach when it is determined that the Email communication has been sent to all of the recipients and that none of the recipients have indicated that the Email communication is to be saved, deleting the stored Email communication. Foladare teaches when it is determined that the Email communication has been sent to all of the recipients and that none of the recipients have indicated that the Email communication is to be saved, deleting the stored Email communication, (e.g. col. 3, lines 15 – 35). It would have been obvious to one skilled in the art at the time the invention was made to combine Foladare with the combined system of Dillon and Arnold because if the Email

communication is no longer needed, the user could have it deleted, therefore freeing up space on the system.

23. As per claim 15, Dillon and Arnold do not specifically teach when it is determined that the Email communication has been sent to all of the recipients and that all of the recipients have indicated that the Email communication can be deleted, deleting the stored Email communication. Foladare teaches when it is determined that the Email communication has been sent to all of the recipients and that all of the recipients have indicated that the Email communication can be deleted, deleting the stored Email communication, (e.g. col. 3, line 55 – col. 4, line 15). It would have been obvious to one skilled in the art at the time the invention was made to combine Foladare with the combined system of Dillon and Arnold because in case a user makes the mistake of deleting information or is unsure if the information selected for deletion is correct, the system would have to have permission to delete the information. This could be used in a form of error checking.

24. Claims 25, 40, 44 are rejected for similar reasons as stated above.

25. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (6067561) in view of Arnold (6275848) in further view of Landfield et al. (5632011) (hereinafter Landfield).

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26. As per claim 26, Dillon and Arnold do not specifically teach automatically sending the Email communication to a non-recipient authorized to access the Email communication. Landfield teaches automatically sending the Email communication to a non-recipient authorized to access the Email communication, (e.g. col. 6, lines 60 – 67). It would have been obvious to one skilled in the art at the time the invention was made to combine Landfield with the combined system of Dillon and Arnold because if there is Email communication data that would have information that is dangerous to the system an non-recipient authorized to access the Email communication, (i.e. administrator), could check it for harmful information that could damage the system.

Response to Arguments

27. Applicant's arguments filed 11/03/2003 have been fully considered but they are not persuasive.

28. In the remarks, Applicant argues in substance that Dillon does not teach anything whatsoever about storing an Email message conditionally based upon anything about the indication, (i.e., IF it is determined that multiple recipients have been indicated). Furthermore, Dillon does not teach, “notifying each of the multiple recipients of the Email to communication [sic] without sending the Email communication to the recipients.”

As to part 1, Examiner would like to draw the attention of the Applicant to what the Applicant has discussed about the references used to read on the claim language. As the Applicant has

suggested, Dillon teaches storing an email message **IF** the user has not accessed the Email account, not requested the Email or is not online. It appears that this type of indication is a type of condition reads on the claim language. If the user is not online then that should be an indication that all Email will be stored in a remote location. The Applicant is suggested to bring in more of the reasons or more specifically the conditions as to why the Email message is stored from the specification. Doing so would put the Application in better light and could overcome the references used for claim language, but would require further search and consideration. As to the Applicant stating that Dillon does not teach, "notifying each of the multiple recipients of the Email to communication [sic] without sending the Email communication to the recipients," Examiner respectfully disagrees. Quoting a section from Dillon, "*Clearly, one important facet of any e-mail system is that e-mail recipients must be notified that they have received e-mail messages so that they know to retrieve them, read them, and, if necessary, respond to them,*" (e.g. col. 1, lines 25 – 32). It is clear that Dillon intends to have multiple users or "e-mail recipients" in his system. This type of language, with what is stated above, reads on the claim language as interpreted by the Examiner.

29. In the remarks, Applicant argues in substance that Arnold does not teach storing the Email message conditionally, based upon whether multiple recipients have been indicated.

30. As to part 2, the Examiner's statements in part 1 and 3, in combination with the prior art of Dillon and Arnold, do indeed teach the prior art as stated broadly in the claim language of the Applicant's invention. Furthermore, in response to applicant's arguments against the references

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individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

31. In the remarks, Applicant argues in substance that the Examiners motivation for combining the references are impermissible hindsight to read the prior art in light of the disclosed invention to find a motivation in the prior art to do what Applicant has done.

32. As to part 3, the Examiner would like to draw the Applicant's attention to the following area of Arnold, (e.g. col. 5, line 44 – col. 6, line 22). In this area of Arnold it is stated that, *"Another embodiment of the invention allows the access list to be modified. For example, a recipient may be added if certain modification rules are met. The modification rules include, for example, whether additional employees are hired, whether additional employees are assigned to a project, whether an intended recipient desires additional individuals to view the attachment, and the like.*

33. *Consolidation of information also may be accomplished by providing information to a certain group of individuals. For example, if a supervisor ordinarily does not receive sales updates, but individuals working for the supervisor do, the access list may be modified such that the supervisor receives sales updates any time that those particular individuals receive the updates.*

34. As it clearly states users can be added to the list of recipients if the sender so wishes therefore, allowing other users, whether new employees or supervisors, access to the email to aid

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the development of the list, or team, of recipients that would have the access to these types of Emails. This does not limit the meaning of the prior art in any way. There are other examples and benefits that are discussed in Arnold and Dillon that could read on the claim language and motivation stated above.

35. When reviewing a reference the applicants should remember that not only the specific teachings of a reference but also reasonable inferences which the artisan would have logically drawn therefrom may be properly evaluated in formulating a rejection. In re Preda, 401 F. 2d 825, 159 USPQ 342 (CCPA 1968) and In re Shepard, 319 F. 2d 194, 138 USPQ 148 (CCPA 1963). Skill in the art is presumed. In re Sovish, 769 F. 2d 738, 226 USPQ 771 (Fed. Cir. 1985). Furthermore, artisans must be presumed to know something about the art apart from what the references disclose. In re Jacoby, 309 F. 2d 513, 135 USPQ 317 (CCPA 1962). The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference. In re Bozek, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969). Every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In re Bode, 550 F. 2d 656, 193 USPQ 12 (CCPA 1977).

Conclusion

36. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 703-305-5333. The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 703-308-5221. The fax phone number for the organization where this application or proceeding is assigned is none.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is none.

David E. England
Examiner
Art Unit 2143

De 


DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100